

### **REMARKS/ARGUMENTS**

Reconsideration of the captioned application as amended herewith is respectfully requested.

- a) Rejected claims 1, 3 – 5, 7 – 8 and 11 - 15 under 35 USC §102(b) as allegedly being anticipated by United States Patent No. 5,084,245 to Berke, et al. ("Berke");
- b) Rejected claims 6, 10 under 35 USC §103(a) as being allegedly unpatentable over Berke in view of United States Patent No. 5,429,804 to Sayles ("Sayles"); and
- c) Rejected claims 2 and 9 under 35 USC §103(a) as being allegedly unpatentable over Berke;

This Response is submitted simultaneously with a petition for a **one (1) month extension of time**, which extends the period of response from 15 April 2008 to 15 May 2008.

New claim 16 was added. Support for this claim may be found in original claim 1 and 8. Claims 7 and 8 were cancelled herein. Claims 1 – 6 and 9 - 16 remain pending in this application after entry of this Response.

Claim 1, which was clarified to include the subject matter from claim 7, provides that "the at least one diagnostic test reagent is provided in or on an annular diagnostic strip extending radially around the inside of the cap," in order to highlight a novel feature of the invention. As such, this amendment does not introduce new matter into the Specification. Applicants' cancellation of claims 7 and 8 and amendment herein is not a concession or admission that original claims 1, 7, 8, or 20 are unpatentable. Applicants reserve the right to prosecute the subject matter of these claims in a continuing application.

#### **I. The Rejection of Claims 1, 3 – 5, 7 – 8 and 11 - 15 Under 35 USC §102(b) Over Berke Should Be Withdrawn**

Claims 1, 3 – 5, 7 – 8 and 11 - 15 stand rejected under 35 USC §102(b) as allegedly being anticipated by Berke. Applicants respectfully disagree for the reasons that follow.

Rejections under 35 USC §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. In re Marshall, 198 USPQ 344 (CCPA 1978). In other words, to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. Id. The exclusion of a claimed element from a prior art reference is enough to negate anticipation under 35 USC §102 by that reference. Atlas Powder Co. v. E.I. Du Pont de Nemours & Co., 224 USPQ 409 (Fed. Cir. 1984). Applicants respectfully submit that Webster does not anticipate Applicants' currently amended claim 1 and claim 20 because Webster does not describe all of those claims' elements.

According to the Office Action, "Berke teaches at least one diagnostic test reagent provided on porous capture elements 42 and 44. See Column 8, lines 18 – 38." Burke further teaches that "capture elements 42 and 44 [are] disposed in alignment with holes 48 and 50" as "best illustrated in exploded view in FIG. 1." See Burke, column 7, lines 49 – 53.

By contrast, the diagnostic cap of claim 1 comprises "at least one diagnostic test reagent ... in or on an annular diagnostic strip extending radially around the inside of the cap." (Emphasis added)

Therefore, because Burke fails to disclose or suggest at least one element of Applicants' claim 1, i.e., e.g., "at least one diagnostic test reagent ... in or on an annular diagnostic strip extending radially around the inside of the cap" (emphasis added), Applicants respectfully submit that the rejection of claim 1 under 35 USC §102(b) has been overcome and should be withdrawn. Applicants further respectfully submit that the rejection of claims 3 – 5 and 11 - 15, which are dependent upon claim 1 and thus incorporate all of the limitations therein, under 35 USC §102(b) has been overcome and should similarly be withdrawn.

## **II. The Rejection of Claims 6 and 10 Under 35 USC §103(a) Over Berke in view of Sayles Should Be Withdrawn**

Claims 6 and 10 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Sayles. Applicants respectfully disagree for the reasons that follow.

According to the Office Action, "Berke differs from the instant claim in failing to teach that the cap is at least partially transparent." The Office Action then cites Sayles for teaching a lid having a transparent area and that "on the rim, around the transparent area, can be written a plurality of indicia."

Claims 6 and 10 are dependent upon independent claim 1 and thus incorporates all of the limitations of claim 1 therein. Assuming *arguendo* that there would be motivation to combine Berke with Sayles, Applicants respectfully maintain that the resulting combination still would lack at least one element in independent claim 1, i.e., e.g., "an annular diagnostic strip extending radially around the inside of the cap" (emphasis added). The Office Action has failed to show where Sayles discloses or suggests the use of such an "annular diagnostic strip" as claimed in independent claim 1. As such, Applicants respectfully submit that the rejection of claim 6 and claim 10 under 35 USC §103(a) as allegedly being unpatentable over Berke in view of Sayles should thereby be withdrawn.

**III. The Rejection of Claims 2 and 9 Under 35 USC §103(a) Over Berke Should Be Withdrawn**

Claims 2 and 9 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Berke. Applicants respectfully disagree for the reasons set forth below.

Claims 2 and 9 are dependent upon independent claim 1 and thus incorporates all of the limitations of claim 1 therein. In view of that fact, Applicants respectfully submit that the rejection of claims 2 and 9 under 35 USC §103(a) as allegedly being unpatentable over Berke has been overcome for the reasons set forth in Sections I and II. herein. As such, Applicants respectfully submit that the rejection of claims 2 and 9 under 35 USC §103(a) as allegedly being unpatentable over Berke should thereby be withdrawn.

### Conclusion

It is submitted that the foregoing amendments and remarks place the case in condition for allowance. A notice to that effect is earnestly solicited.

In the event that all of the claims are not in condition for allowance, Applicants respectfully request for an interview with the Examiner before the preparation of the next Office Action.

Respectfully submitted,

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Dated: 12 May 2008

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Petition for a one (1) month extension of time